

Amendments to the Drawings:

The attached sheets of drawings include changes to Page 1 of 2 and Page 2 of 2 with changes to Fig. 1A and Fig. 3. In Fig. 1A the drain pipe 34 is drawn as L-shaped consistent with Fig. 3 and numerals have been added. In Fig. 3 numerals have been added.

Attachment: Replacement Sheet Page 1 of 2
 Replacement Sheet Page 2 of 2
 Annotated Sheets Showing Changes

REMARKS/ARGUMENTS

Claims 1 and 2 are pending in the present application. The drawings are objected to under 37 C.F.R. § 1.83(a) because the drawings do not show every feature of the invention. The specification is objected to as failing to provide proper antecedent basis for the claim terminology. Claim 2 is rejected under 35 U.S.C. § 112 first paragraph for failing to comply with the enablement requirement. The Examiner has provided a provisional non-statuatory double patenting rejection based on the judicially created doctrine grounded in public policy to prevent the unjustified or improper timewise extension of the right to exclude granted by a patent. Applicant with this response files a Terminal Disclaimer under 37 C.F.R. § 1.321 regarding U.S. Serial No. 10/247,247. Claims 1 and 2 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Oropallo, et al., (U.S. Pat. No. 6,618,875) in view of Altman, et al., (U.S. Pat. No. 4,240,166). Applicant respectfully traverses all rejections.

The Examiner has objected to the drawings under 37 C.F.R. § 1.83(a). Specifically the Examiner raises four issues. First, the Examiner asserts that the drawings do not show a drain pipe having an inverted L-shape as called for by claim 1. Fig. 1A has been amended to provide a drain pipe of one piece construction that has an L-shape. This L-shaped drain pipe is shown in Fig. 3 and thus the drawing change has proper antecedent basis in the original disclosure. Thus, this drawing rejection is considered overcome.

The Examiner has also asserted that the drawings do not contain the claimed subject matter of a drain pipe..... including a horizontal leg extending into and through the overflow port of the bathtub, and a vertical leg extending

downwardly for connection to a fluid drain system. As discussed above, Fig. 1A has been amended to make the overflow drain pipe an L-shape such that it has a horizontal portion 35A and a vertical portion 35B that extends to a fluid drain system 39. Additionally, the L-shaped description of the drain pipe along with the description of the horizontal leg and the vertical leg extending to the fluid system has been added in an amendment to the specification. This amendment to the drawing, Fig. 1A and to the specification gains antecedent basis in the original claims and in Fig. 3. Again, specifically Fig. 3 shows the overflow drain pipe 34 that has an L-shape with a horizontal portion 35A and a vertical portion 35B. As seen in Fig. 3, the pipe includes the threaded end portion that is part of the horizontal leg. Thus, the amendments to the drawings and specification has proper antecedent basis within the originally filed application.

The Examiner has objected to the phrase "fluid drain system" as not shown in the drawings. The fluid drain system 39 comprises the horizontal pipe 36 and drain pipe 38. This description has been added to the specification and numeral 39 has been added to Fig. 1A to show the same. As the horizontal pipe 36 and the drain pipe 38 are both presented in original Fig. 1A, this amendment to the drawings and specification has proper antecedent basis in the original specification.

The next limitation that the Examiner asserts is not provided by the drawings is "an overflow pipe having a first exposed end and a second end in communication with a fluid source". Claim 1 has been amended to require a second end in communication with a fluid drain system instead of a fluid source. Additionally the specification has been amended at page 4, lines 10 and 11 to discuss a first exposed end 63A of overflow drain pipe 34 that extends through the overflow port

30. Applicant has also amended the specification to add the overflow drain pipe 34 also has a second end in communication with a fluid drain system 39. As seen this amendment gains antecedent basis from the claims and from Fig. 1A that has been amended to provide Figures 63A and 63B showing these elements that are properly within the original drawings. Thus no new matter has been entered and all the drawings objections are considered overcome.

The specification has been objected to for failing to provide proper antecedent basis for several claim terminologies. The first claim terminology is "an overflow system for a bathtub". The Applicant has added this limitation to page 3, line 23 of the specification and has added numeral 27 to Fig. 1A that shows the overflow system. This amendment gains antecedent basis from the original application and specifically from Fig. 1A that shows the overflow system.

The next objection to the specification is that it does not provide a drain pipe having an inverted L-shape. Page 3, line 28 has been amended to state that overflow drain pipe has an inverted L-shape. This amendment gains its antecedent basis from the original claims of the parent application, Serial No. 10/247,247 and the original claims in this application. Additionally this limitation gains antecedent basis from Fig. 3 that shows a overflow drain pipe 34 that has an inverted L-shape.

The next limitation objected to by the Examiner is "drain pipe....including a horizontal leg extending into and through the overflow port of the bathtub, and a vertical leg extending downwardly for fluid connection to a fluid drain system". As discussed above regarding the drawings, this limitation has been added to the specification and gains proper antecedent basis from the original claims and original Figs. 1A and 3.

The next limitation objected to by the Examiner is "fluid drain system". As discussed above regarding the drawings, the fluid drain system 39 has been specifically identified in the amendment to the drawings in Fig. 1A and was present in the original application. Thus no new matter has been added and this specification rejection is considered overcome.

The next objection is to the use of the term "a solid cap" in claims 1 and 2. Claims 1 and 2 have been amended to require a solid plug. Page 4 of the original specification at lines 5 and 6 refers to numeral 52 that designates a solid plug. Thus this specification objection is considered overcome.

The next limitation of the specification is objected to is "a solid cap threaded into interior threads of the horizontal leg extending through the overflow port to close the end of the horizontal leg". This exact limitation has been added to the specification at page 4, line 11 and as discussed above regarding the amendments to the drawings, has proper antecedent basis within Figs. 1A and 3 of the original application and also within original claims 1 and 2. Specifically Fig. 3 shows this closed arrangement.

The next claim limitation the Examiner objects to is "a plumbing test system". The specification at page 4, line 5 has been amended to state that with reference to Figs. 2 and 3, both Figures show parts to a plumbing test system 51. Numeral 51 has been added to Fig. 1A and thus the plumbing test system was provided in the original specification and this amendment has proper antecedent basis. Thus this objection is considered overcome.

The next limitation the Examiner objects to is "an overflow pipe having a first exposed end and a second end in communication with the fluid source". As discussed above regarding the drawings, claim 2 has been amended such that the

second end is in communication with a fluid drain system and text has been added to the specification at page 4, lines 10 and 11 to provide proper antecedent basis to this claim limitation. Again, as argued above, no new matter has been entered.

The next claim limitation objected to is "a fluid source" is called for in claim 2. This limitation has been eliminated and replaced with fluid drain system that has proper support in the specification. Thus, this objection is considered overcome.

The next limitation that was objected to was "wherein a portion of the cap is composed of a material capable of sealing the first end when the cap is threaded onto the first end" as called for by claim 2. The specification at page 4 has been amended at lines 5-9 to state "the numeral 52 designates a solid plug that is composed of a material such as a plastic or metal material that is capable of sealing the first end 63A of the overflow drain pipe 34 when the plug 52 is threaded on to the first ends 63A as shown in Fig. 3". This amendment to the specification is identical to the claim limitation and gains its antecedent basis from the original claim and from Fig. 3. Fig. 3 shows a plug 52 that seals the first end 63A of an overflow drain pipe 34 that is threaded into the first end of that pipe. Because Fig. 3 shows a seal, the solid plug must be made of a material that is capable of sealing. Furthermore, plastic and metal are examples of embodiments of this material that are able to seal. Thus, proper antecedent basis is found in the original specification, the original claims and original Fig. 3 for this claim limitation. Consequently, the objection is considered overcome.

Finally, claim 2 is objected to for having an informality that has been corrected. Thus all the claim objections are considered overcome.

Claim 2 is rejected under 35 U.S.C. § 112 first paragraph as failing to comply with the enablement requirement. For a rejection by the Examiner based on a lack of enablement requirement, the Examiner has the initial burden to establish a reasonable basis to question the enablement provided for the claimed invention. See MPEP 2164.04. Specifically, when rejecting a claim under the enablement requirement of section 112, the Examiner bears the "initial burden of setting forth a reasonable explanation as to why [he/she] believes that the scope of protection provided by [the] claim is not adequately enabled by the description of the invention provided in the specification." In re Wright, 999 F.2d 1557, 1562, 27 USPQ2d 1510, 1513 (Fed. Cir. 1993). To object to a specification on the grounds that the disclosure is not enabling with the respect to the scope of the claim sought to be patented, the Examiner must provide evidence or technical reasoning sustaining those doubts. Id; and MPEP 2164.04. Without a reason to doubt the truth of the statements made in the patent application, the application must be considered enabling. In re Wright, 999 F.2d 1557, 1562, 27 USPQ2d 1510, 1513 (Fed. Cir. 1993); In re Marzocchi, 439 F.2d 220, 223, 169 USPQ 367, 369 (CCPA 1971). Accordingly, the case law makes clear that properly reasoned and supported statements explaining any failure to comply with section 112 are a requirement to support a rejection. In re Wright, 999 F.2d 1557, 1562, 27 USPQ2d 1510, 1513 (Fed. Cir. 1993).

The original specification shows a plug 52 that seals the end of a overflow drain pipe 34. Additionally the original specification states "the numeral 52 designates a solid plug that is plastic or metal material". Thus the original specification identifies two types of material, plastic and metal that are capable of sealing the first end when the cap is

threaded onto the first end. There is no reason to doubt that plastic or metal material will properly seal the end of overflow drain pipe 34 as suggested in the original claims. Thus, the application must be considered enabling. In re Wright, 999 F.2d 1557, 27 USPQ2d 1510 (Fed. Cir. 1993). Additionally Applicant asserts that the Examiner has not provided evidence or technical reasoning to sustain doubts that the disclosure does not enable one skilled in the art to make a plug of a material that is able to seal the end of an overflow drain pipe. Thus because the Examiner has not provided evidence or technical reasoning why the Applicant's original specification is not enabling, coupled with the original claim and the examples of the plastic and metal material that the plug may be made from, Applicant asserts that the original specification is enabling under 35 U.S.C. § 112. Consequently, Applicant respectfully requests that the 35 U.S.C. § 112 rejection be withdrawn.

The Examiner has rejected claims 1 and 2 under 35 U.S.C. § 103A as being unpatentable over Oropallo in view of Altman. There is no suggestion or motivation to combine the prior art to make out a *prima facie* case of obviousness. An obviousness analysis begins in the text of section 103 with the phrase "at the time the invention was made." For it is this phrase that guards against entry into the "tempting but forbidden zone of hindsight when analyzing the patentability of claims pursuant to that section. See Loctite Corp. v. Ultraseal Ltd., 781 F.2d 861, 873, 228 USPQ 90, 98 (Fed. Cir. 1985), overruled on other grounds by Nobelpharma AB v. Implant Innovations, Inc., 141 F.3d 1059, 46 USPQ 2d 1097 (Fed. Cir. 1998). Measuring a claimed invention against the standard established requires the often difficult but critical step of casting the mind back to the time of the invention, to consider the thinking of one of ordinary skill in the art, guided only by the prior art references and

then-accepted wisdom in the field. See, e.g. W.L. Gore & Assoc., Inc. v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 313 (Fed. Cir. 1983). Close adherence to this methodology is especially important in the case of less technologically complex inventions, where the very ease with which the invention can be understood may prompt one "to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against the teacher." Id.

The best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references. See, e.g., C.R. Bard, Inc. v. M3 Sys., Inc., 157 F.3d 1340, 1352, 48 USPQ 2d 1225, 1232 (Fed. Cir. 1998) (describing "teaching or suggestion or motivation [to combine] as an essential evidentiary component of an obviousness holding") combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability - the essence of hindsight. See, e.g. Interconnect Planning Corp. v Feil, 774 F.2d 1132, 1138, 277 USPQ 543, 547 (Fed. Cir. 1985) ("The invention must be viewed not with the blueprint drawn by the inventor, but in the state of the art that existed at the time.") In this case, the Examiner has fallen into the hindsight trap.

Evidence of a suggestion, teaching or motivation to combine may flow from the prior art references themselves, the knowledge of one of ordinary skill in the art, or, in some cases, from the nature of the problem solved, although the suggestion more often comes from the teachings of the pertinent references. Rouffet, 149 F.3d at 1355. The range of sources available does not diminish the requirement for actual evidence. That showing must

be clear and particular. See, e.g., C.R. Bard, 157 F.3d at 1352. Broad conclusory statements regarding the teaching of multiple references, standing alone, are not evidence. e.g., McElmurry v. Arkansas Power & Light Co., 995 F.2d 1576, 1578, 27 USPQ 2d 1129, 1131 (Fed. Cir. 1993) ("Mere denials and conclusory statement, however, are not sufficient to establish a genuine issue of material fact.").

All the obvious rejections asserted by the Examiner are based on a combination of prior art references, e.g., the conventional overflow assembly Oropallo, combined with the threading of the horizontal leg and element numbered 370 of Altman. To justify this combination the Examiner stated "it would have been obvious to one of ordinary skill in the bathtub art, at the time the invention was made, to employ an internally threaded pipe that engages an externally threaded cap in Oropallo especially in view of the teachings of Altman, et al. to secure the cap to the pipe wherein so doing would involve mere substitution of one well known securing mechanism for another within the bathtub art". (Office Action, page 7).

The Examiner does not provide a reason or motivation why to make this combination other than stating that doing so would involve a mere substitution of one well known securing mechanism for another. Additionally the Examiner has not identified within the references a suggestion or motivation to adapt the overflow system of Oropallo with the threaded pipe and threaded element 370 of Altman.

Altman teaches the horizontal end 362 of elbow 360 has an internally threaded portion 364 which threadably engages an externally threaded portion 366 formed on a stem portion 368 of an outlet 370. (Col. 5, lines 55-59). First this arrangement is shown in a drain assembly (see Fig. 2) and additionally numeral 370 is defined as an outlet. As seen in Fig. 2, a cut

away of Fig. 370 shows a passageway that extends through the outlet 370 to allow water to pass out of the drain system 370. Thus the purpose of Altman is to allow water to flow through the drain assembly. This is the opposite to the purpose of Oropallo that teaches using a cover to prevent water flow during pressure testing. (See Col. 1, lines 11-20 and 65-67). Thus combining the outlet 370 of Altman with the overflow system of Oropallo would not accomplish the purpose of Oropallo. Therefore Applicant submits there is not a motivation to combine the two references.

At best the prior art suggests an alternative way of frictionally engaging a plumbing line 11 of Oropallo to overflow port 12 through use of an element having an outlet 370 (from Altman) and not an alternative device for testing the water. The only way based on the teachings of the prior art, to arrive at the claimed invention, is to use the claim as a frame, taking individual, naked parts of separate prior art references where employed as a mosaic to recreate a facsimile of the claimed invention. W.L. Gore & Associates v. Garlock, Inc., 721 F.2d, 1540, 1552 (Fed. Cir. 1983). At no point does the Examiner explain why the mosaic would have been obvious to one skilled in the art, or what would have caused those skilled in the art to disregard the passageway of outlet 370 of Altman to make such a mosaic.

Thus Applicant asserts that the Examiner has succumbed to hindsight reconstruction by combining through the prior art to find teachings on the various aspects of the claimed invention, and declaring the claimed invention obvious in light of those references. In re Fine, the Federal Circuit specifically warned against such "picking and choosing among isolated disclosures in the prior art falling victim to the insidious affect of a hindsight syndrome". 837, F.2d at 1075. To imbue one of

ordinary skill in the art with knowledge of the invention in suit, when no prior art reference or references of the record convey or suggest that knowledge, is to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used its teacher. W.L. Gore, 721 F.2d at 1553.

Even if there is a motivation to combine the prior art references, the combination would not provide each and every limitation of independent claims 1 and 2.

The teachings or suggestions to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in Applicant's disclosure. See In re Vacck, 997 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991); MPEP § 2143. To establish a *prima facie* case of obviousness, all the claim limitations must be taught by the prior art. In re Royka, 490 F.2d 981, 180 U.S.P.Q. 580 (CCPA 1974). "All words in a claim must be considered in judging the patentability of that claim against the prior art." In re Wilson, 57 C.C.P.A. 1029, 1032 (1970).

Independent claim 1 requires "a solid plug threaded into interior threads of the horizontal leg extending through the overflow port to close the end of the horizontal leg". Independent claim 2 requires "a solid plug threadably mounted in the first end and wherein a portion of the plug is comprised of a material capable of sealing the first end when the plug is threaded onto the first end". In the Examiner's combination, the Examiner uses the overflow system of Oropallo and combines it with the pipe threading and element 370 of Altman. As discussed above, the element 370 is defined as an outlet 370 and as shown in Fig. 2 this outlet has a passageway therein that allows flow of fluid through this drainage system. Thus if the element 370 was used as a substitute to the cap of Oropallo the

combination would teach a "cap" or element 370 that has a fluid opening therein. Thus, the overflow system and plumbing test system resulting from the combination of Oropallo and Altman would not teach a solid plug as required in both claim 1 and 2 nor would it teach a solid plug that closes the end of the horizontal leg as required in claim 1. Thus, each and every limitation of amended claims 1 and 2 would not be met by the proposed combination. For at least these reasons independent claim 1 and 2 are also considered in allowable form. Thus Applicant respectfully requests allowance of the claims.

CONCLUSION

If any issues remain that may be expeditiously addressed in a telephone interview, the Examiner is encouraged to telephone the undersigned at 515/558-0200.

No fees or extensions of time are believed to be due in connection with this amendment; however, consider this a request for any extension inadvertently omitted, and charge any additional fees to Deposit Account 50-2098.

Respectfully submitted,



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Application No. 10/674,739
Reply to Office Action dated 9/30/05
Annotated Sheet Showing Changes

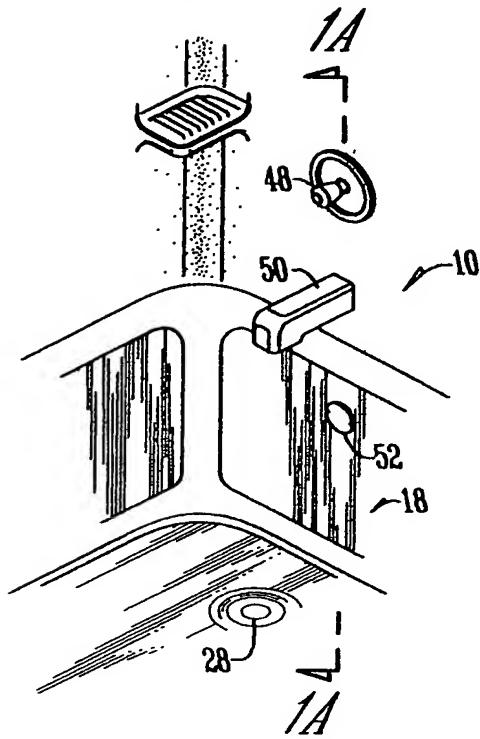


Fig. 1

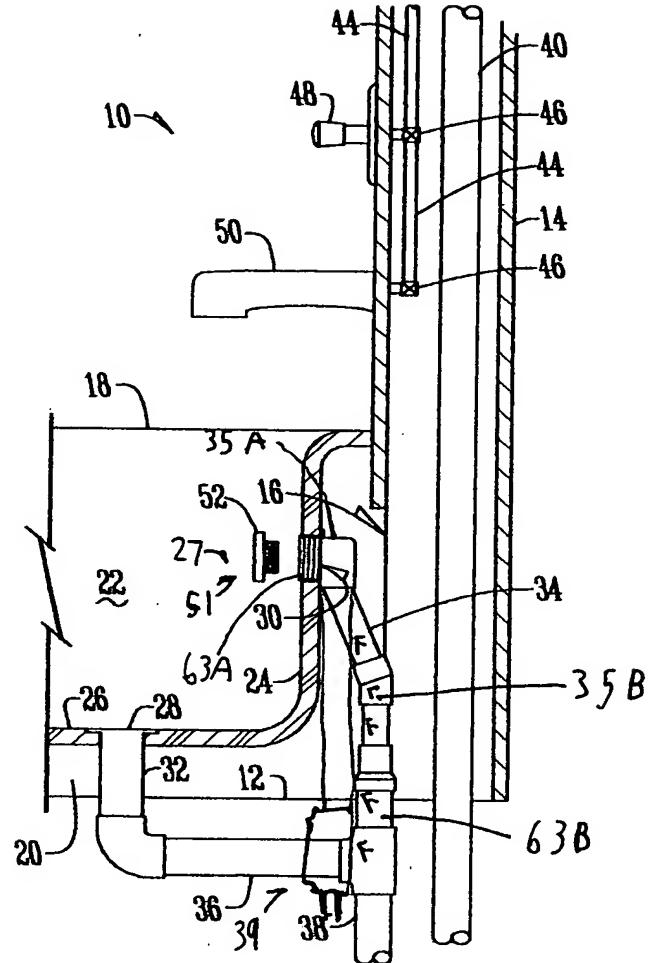


Fig. 1A

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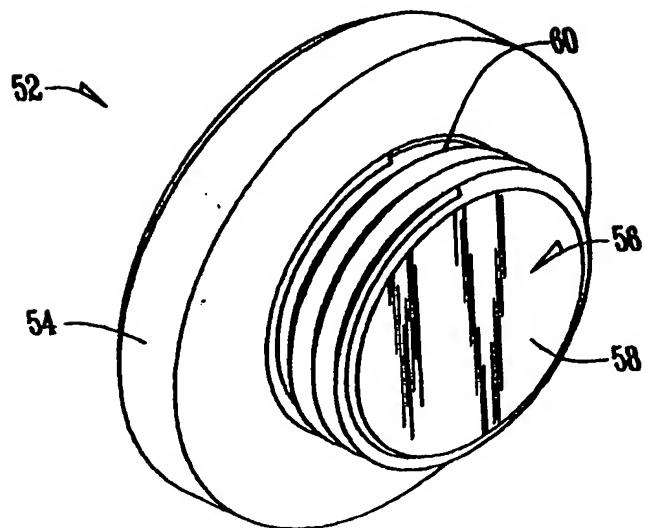


Fig2

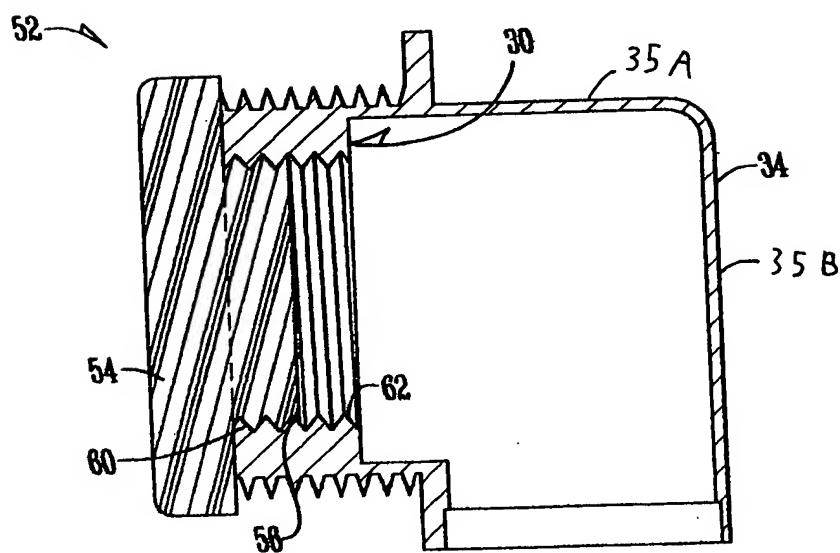


Fig3